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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,104	08/04/2003	Reza Mehrabi	AVERP3308USA	6382

7590 09/21/2004

Jonathan A. Platt  
Renner, Otto, Boisselle & Sklar, LLP  
Nineteenth Floor  
1621 Euclid Avenue  
Cleveland, OH 44115-2191

EXAMINER

LECHERT JR, STEPHEN J

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/634,104	Applicant(s) MEHRABI ET AL.	
	Examiner Stephen J. Lechert Jr.	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 49-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 and 60-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-15 and 9-1-2004</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**1. Applicant's election without traverse of Group I in the reply filed on 9-1-2004 is acknowledged. Accordingly, claims 49-59 have been withdrawn. Action on merits 1-48 and 60-65 follows:**

**2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).**

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

**3. Claims 1-48 and 60-65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-33 of copending Application No. 10/734,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications**

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**claim a method of patterning or embossing a sheet material using a patterned tool which is pressed against a sheet, while maintaining the pressure, radiantly heating the sheet using near-infrared radiant energy from a radiant energy source and wherein the radiant heating includes passing the radiant energy through a relatively radiantly transparent material in contact with the sheet. In the instant case, the claims are broader than what has been claim in the '379 case, in the sense that the sheet is not claimed as an optical anisotropic uniaxial oriented polymer sheet and does not include the specific pattern which is being embossed. It is maintained that although the '379 is more specific, the method of the instant application could provide the same type of sheet as the specific modifications and patterned and type of sheet material selection would have been obvious to one having ordinary skill in the art at the time the invention was made.**

**This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.**

**4. With a properly executed and timely filed Terminal Disclaimer, this case would be in condition for allowance as a process for providing a method of embossing a sheet material, comprising pressing a patterned tool against the sheet which is concomitantly heated using a radiant heat source providing near infrared radiant energy, wherein the radiant heating includes passing the radiant energy through a relatively radiantly-transparent material in contact with the sheet. The radiantly transparent material is at least a part of the roller which contacts the sheet. The concept of providing the radiantly transparent material which contacts the sheet during near-infrared radiant heating and pressure step provides an embossing method which has not been taught or fairly suggested either singularly or in combination by the prior art.**


**5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wisotzky et al. and Chirhart et al. both disclose embossing or patterning a sheet material using infrared heating device but do not teach the concept using near-infrared**

**energy range nor using a relatively radiantly transparent tool or roller in contact with the sheet.**

**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 571-272-1203. The examiner can normally be reached on 9:30-6:00.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianne can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.**

**Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

  
**Stephen J. Lechert Jr.**  
**Primary Examiner**  
**Art Unit 1732**